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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,692	09/22/1999	PAUL DAVID TATARKA		4999

7590 11/27/2002

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EXAMINER

JACKSON, MONIQUE R

ART UNIT PAPER NUMBER

1773

DATE MAILED: 11/27/2002

15

Please find below and/or attached an Office communication concerning this application or proceeding.

AS15

Office Action Summary	Application No. 09/401,692	Applicant(s) TATARKA ET AL.	
	Examiner Monique R Jackson	Art Unit 1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-108 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 9/16/02 has been entered. Claims 1-108 are pending in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 72-75, 78, 80, 81, 84 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhoit et al (USPN 5,928,740) for reasons as generally stated in the prior office action and recited below.
4. Wilhoit et al teach a polymer blend and mono- and multilayer films made therefrom having improved properties such as heat sealing or puncture resistance particularly useful in making heat shrinkable, oriented films for packaging food and non-food articles, wherein the blend has a first polymer comprising a copolymer of ethylene and at least one C₃-C₁₀ α-olefin having a polymer melting point between 55 and 75°C; a second polymer comprising a copolymer of ethylene and at least one C₃-C₁₀ α-olefin having a polymer melting point between 85 and 110°C, such as C₂C₆ (*reads on the first polymer of the instant invention*); a third thermoplastic polymer, preferably a copolymer of ethylene and at least one C₃-C₁₀ α-olefin, having a melting point between 115 and 130°C (*reads on the second polymer of the instant invention*); and a preferred fourth polymer having a melting point between 80-105°C such as copolymers of ethylene and unsaturated esters like ethylene vinyl acetate and ethylene alkyl acrylates (*reads on the third polymer of the instant invention*; Abstract; Col. 1, lines 5-10; Col. 7, lines 24-40; Col. 8, line 62 – Col. 9, line 17.) Wilhoit et al teach that it is to be understood that

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the use of the term "copolymer of ethylene" means that the copolymer is predominantly comprised of ethylene with that at least 50% by weight of the copolymer derived from ethylene monomer units in forming the copolymer with suitable α -olefins including C_3 to C_{10} α -olefins such as propene, butene-1, pentene-1, **hexene-1**, methylpentene-1, **octene-1**, decene-1 **and combinations thereof** such that the invention contemplates use not only of bipolymers, but copolymers of multiple monomers such as terpolymers e.g. ethylene-butene-1-hexene-1 terpolymer (Col. 6. lines 56-67.) Wilhoit et al teaches that the blend preferably comprises at least 10wt% of the first ethylene polymer, preferably 20-35wt% of the total polymer content of the four component blend, with use of lesser amounts reducing the shrinkability and higher amounts making orientation more difficult and possibly increasing extractable moieties to amounts which are undesirable for certain applications; at least 10wt% of the second ethylene polymer, preferably from about 30 to 70wt% of the total polymer weight of the polymer blend, preferably 25 to 60wt% in the preferred four component blend, wherein use of lesser amounts reduces puncture resistance in those embodiments where puncture resistance is desired; at least 10wt% of the third ethylene polymer, preferably about 10 to 30wt% of the total polymer content of the four component blend; and about 10 to 30wt% of the fourth ethylene vinyl ester or alkyl acrylate copolymer of the total weight of the polymer blend.

5. Though Wilhoit et al does not specifically teach the entire weight ranges as recited in the instantly claimed invention, when computing the weight percentages based on the weight of only the second, third and fourth polymers of Wilhoit et al, which correspond to the three polymer blend of the instant application, the weight percentages overlap or fall within the instantly claimed ranges for the first, second, and third polymers, respectively (Col. 7, lines 46-58; Col. 8,

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lines 14-26 and lines 49-61; Col. 9, lines 23-26.) Therefore, given the teachings of Wilhoit et al, one having ordinary skill in the art at the time of the invention would have been motivated to utilize any of the polymers taught by Wilhoit et al within the melting point ranges recited including hexene-1 as the C₃-C₁₀ α -olefin in the second ethylene copolymer having a polymer melting point between 85 and 110°C and to utilize any amounts within the ranges disclosed by Wilhoit et al given the reasonable expectation of success and given that Wilhoit et al teach that the amount of the first polymer is a result-effective variable with use of lesser amounts reducing the puncture resistance.

6. With regards to process claims 80, 81, 84 and 85, Wilhoit et al further teach that the polymer blend can be utilized to form an inner layer of a multilayer tubular film wherein in a preferred process for making an oriented or heat shrinkable film, a primary tube comprising the polymer blend is extruded and after leaving the die is inflated by admission of air, cooled, collapsed, and then preferably oriented by reinflating to form a secondary bubble with reheating to the film's orientation or draw temperature range with suitable machine direction and transverse direction stretch ratios from about 3:1 to about 5:1 with a ratio of about 4:1 preferred (Col. 11, lines 16-36.) Wilhoit et al teach that the films may be monolayer or multilayer films preferably of 10 mils or less (Col. 11, lines 37-38.) Wilhoit et al teach that the drawing point or orientation temperature is below the melting point of each layer to be oriented and above the layer's Vicat softening point with examples utilizing a draw point temperature between about 71-79°C and further teach that draw point temperature, bubble cooling rates and orientation ratios are generally adjusted to maximize bubble stability with use of higher throughput rates and lower

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draw point temperatures believed to provide films having higher puncture resistance relative to use of lower throughputs or higher orientation temperatures (Col. 14, lines 33-43.)

7. Hence, though Wilhoit et al teach an example draw point within the instantly claimed temperature ranges, Wilhoit et al does not specifically limit the invention to a draw point temperature of from 65° to 88°C or 68° to 79°C as instantly claimed. However, based on the teachings of Wilhoit et al one having ordinary skill in the art at the time of the invention would have been motivated to utilize routine experimentation to determine the optimum draw point temperature for a particular film composition or the optimum operating conditions for a particular process based on the desired puncture resistance of the resulting film given the reasonable expectation of success.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent **and to prevent possible harassment by multiple assignees** (*emphasis added*.) See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-108 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-111 of U.S. Patent No. 09/431,931 in view of Wilhoit et al (USPN 5,928,740) for the reasons recited in the prior office action.

Response to Arguments

10. Applicant's arguments filed 9/16/02 have been fully considered but they are not persuasive and/or moot in view of the new grounds of rejection. In terms of the provisional obviousness double patenting rejection, the Examiner maintains that the instant invention is obvious over application 09/431,931 given that octene-1, hexene-1, other C₃ to C₁₀ α -olefins, as well as combinations thereof, are functional equivalents in the art with regards to ethylene copolymers, and one skilled in the art would have been motivated to utilize octene-1 in place of or in combination with the hexene-1 of application 09/431,931 given the reasonable expectation of success. With regards to Applicants' arguments for not filing a terminal disclaimer due to the same effective filing dates of both applications, it is noted that the "unjustified or improper timewise extension" is not the sole reason underpinning the judicially created obviousness-type double patenting rejection. As stated above, the "nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent **and to prevent possible harassment by multiple assignees**" (*emphasis added*.) Hence, a timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) is required in order to overcome the provisional double patenting rejection as stated above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 703-308-0428. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul J Thibodeau can be reached on 703-308-2367. The fax phone numbers for the

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organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Monique R. Jackson
Patent Examiner
Technology Center 1700
November 25, 2002